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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,509	12/07/2000	Thomas Schaeck	DE919990082	1249

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EXAMINER

COLIN, CARL G

ART UNIT PAPER NUMBER

2136

DATE MAILED: 05/06/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,509

Applicant(s)

SCHAECK ET AL.

Examiner

Carl Colin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 6) ☐ Other:

DETAILED ACTION

1. Pursuant to USC 131, claims 1-15 are presented for examination.

Claim Objections

2. **Claim 12** is objected to because it is substantial duplicate of claim 11. Applicant is advised that should **claim 12** be found allowable, **claim 11** will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 3.1 **Claims 1-15** are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4,900,904 to **Wright et al.**

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3.2 **As per claims 1, 11, and 12, Wright et al.** discloses a method for operating chipcard applications in a chipcard application system comprising at least one chipcard and at least one terminal, the system being provided with card holder verification means comprising in turn at least PIN and a chipcard ID, the method comprising: checking the presence of an initial trusted association between at least one preferred terminal and said chipcard, for example (see column 8, line 55 through column 9, line 33); and subsequently running the remainder of the chipcard application program in case that said trusted association is present, for example (see column 9, lines 5-32 et seq.; column 9, lines 51-67; and column 10, lines 48-65).

As per claim 2, Wright et al. discloses the claimed method according to claim 1 in which said checking the presence of said trusted association comprises comparing the chipcard-Id stored on the chipcard with one or more chipcard-Ids stored in the terminal, for example (see column 6, lines 44-60; column 8, line 45 through column 9, line 33; and column 10, lines 30-47). (See also column 16, lines 46-67).

As per claim 3, Wright et al. discloses the claimed method according to claim 1 in which said checking the presence of said trusted association comprises comparing the Terminal ID of the terminal with one or more terminal Ids stored on the Chipcard, for example (see column 9, lines 5-33).

As per claim 4, Wright et al. discloses the claimed method according to claim 1 further comprising controlling the presence of said initial association by controlling means which are

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provided via a network the terminal or the chipcard is connectable to, for example (see column 18, lines 38-61).

As per claim 5, Wright et al. discloses the claimed method according to claim 2 in which said initial association is stored in storage means of said terminal and comprises an association between at least one preferred terminal and a plurality of chipcards, for example (see column 8, lines 45-55).

As per claims 6-7, Wright et al. discloses the limitation in which a PIN is checked hidden from the chipcard use, for example (see column 9, lines 5-33 and column 10, lines 20-47).

As per claims 8-9, Wright et al. discloses the claimed method according to claim 2 in which the presence of the trusted association is the only criterion for entering the remainder of the chipcard application program, for example (see column 11, lines 30-33).

As per claim 10, Wright et al. discloses a terminal device having storing means for storing its terminal-ID and at least one pair of matching chipcard-ID and PIN and logic circuit means for performing the steps of the method according to claim 1, for example (see column 6, lines 44-60; column 8, line 45 through column 9, line 33; and column 10, lines 30-47). Claim 10 is similar to claim 1 except for incorporating the claimed method into a terminal device. Therefore, claim 10 is also rejected on the same rationale as the rejection of claim 1.

As per claim 13, Wright et al. discloses a terminal device having storage means for storing its terminal-ID and making it accessible by a chipcard-resident application program, for example (see column 8, line 45 through column 9, line 33).

As per claim 14, Wright et al. discloses a chipcard usable for interaction with the terminal device according to claim 13, the chipcard having means for storing its chipcard-ID, at least one terminal-ID and a PIN, for example (see column 6, lines 44-60; column 8, line 45 through column 9, line 33; column 16, lines 46-67).

As per claim 15, Wright et al. discloses a chipcard according to claim 14, further having logic circuit means for performing: checking the presence of an initial trusted association between at least one preferred terminal and said chipcard; and subsequently running the remainder of the chipcard application program in case that said trusted association is present, for example (see column 9, lines 5-32 et seq.; column 9, lines 51-67; and column 10, lines 48-65). (See also column 6, lines 11-65)

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the art discloses the use of cards and terminal devices with capability for storing and matching identification codes and plurality of other data.

US Patents:	4,810,862	Nakano et al.
	5,585,787	Wallerstein

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4.1 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 703-305-0355. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

ce

Carl Colin

Patent Examiner

May 3, 2004

Ayaz Sheikh
AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
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